



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,293	05/25/2001	Michael E. Aufricht	1933.0010008	3536

26111 7590 08/25/2004

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

YOUNG, JOHN L

ART UNIT PAPER NUMBER

3622

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,293

Applicant(s)

AUFRICHT ET AL.

Examiner

John L Young

Art Unit

3622

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

[Signature]
8-23-2004

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5-8.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3622

NON-FINAL REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful
process, machine, manufacture, or composition of matter or
any new and useful improvement thereof, may obtain a
patent therefore, subject to the conditions and requirements
of this title.

2. Claims 1-15, 31-35, 41 & 43-45 are rejected under 35 U.S.C. 101, because said claim is directed to non-statutory subject matter.

As per claims 1-15, 31-35, 41 & 43-45, as drafted said claims are not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA

Art Unit: 3622

1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b), even though said claims are limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75, 47 USPQ 2d at 1602 (Fed Cir. 1998); *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999)

Note: it is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05(q)).

CLAIM REJECTION — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-45 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wynblatt 6,219,696 (04/17/2001) [US f/d: 8/1/1997] (herein referred to as "Wynblatt").

As per claim 1, Wynblatt (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 5-10; col. 1, ll. 60-67; col. 2, ll. 1-10; col. 2, ll. 22-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col.

Art Unit: 3622

5, ll. 1-67; col. 6, ll. 1-55) shows a “method for placing advertisement with interactive content on devices . . . displaying an advertisement with interactive content on a device; and . . . pre-populating at least one field of the advertisement with address location information relating to the user of the device.”

Wynblatt lacks explicit recitation of “pre-populating at least one field of the advertisement with address location information relating to the user of the device.”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Wynblatt (the ABSTRACT; FIG. 1; FIG. 2) implicitly shows “pre-populating at least one field of the advertisement with address location information relating to the user of the device. . . .” and it would have been obvious to modify and interpret the disclosure of Wynblatt cited above as implicitly showing “pre-populating at least one field of the advertisement with address location information relating to the user of the device. . . .”, because modification and interpretation of the cited disclosure of Wynblatt would have provided means “*which allows access to Internet information customized to roadside advertisements. . . .*” (see Wynblatt col. 1, ll. 59-67), based on the motivation to modify Wynblatt so as to provide “*the simplest case . . . [where in] a local advertisement, a local agent could be included in a store front, and the mobile agents could be in automobiles. . . . As a driver passes by the store. . . .*” (see Wynblatt (col. 5, ll. 48-60)).

Art Unit: 3622

As per claims 2-6 Wynblatt shows the method of claim 1 and subsequent base claims depending from claim 1.

Wynblatt (FIG. 1 & FIG. 2; and col. 2, ll. 47-67) shows the pre-populating address elements and limitations of claims 2-6.

Wynblatt lacks explicit recitation of the pre-populating address elements and limitations of claims 2-6.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 2-6 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Wynblatt (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 5-10; col. 1, ll. 60-67; col. 2, ll. 1-10; col. 2, ll. 22-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-55) implicitly shows the pre-populating address elements and limitations of claims 2-6; and it would have been obvious to modify and interpret the disclosure of Wynblatt cited above as showing each and every element in dependent claims 2-6, because modification and interpretation of the cited disclosure of Wynblatt would have provided means "*which allows access to Internet information customized to roadside advertisements. . . .*" (see Wynblatt col. 1, ll. 59-67), based on the motivation to modify Wynblatt so as to provide

Art Unit: 3622

“the simplest case . . . [where in] a local advertisement, a local agent could be included in a store front, and the mobile agents could be in automobiles. . . . As a driver passes by the store. . . .” (see Wynblatt (col. 5, ll. 48-60)).

As per claims 7-12 Wynblatt shows the method of claim 1 and subsequent base claims depending from claim 1.

Wynblatt (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 5-10; col. 1, ll. 60-67; col. 2, ll. 1-10; col. 2, ll. 22-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-55) implicitly shows advertisement fee elements and limitations (see claim 7) and advertisement content display and loading elements and limitations (see claims 7-12); however,

Wynblatt lacks explicit recitation of the fee elements and limitations and advertisement content display and loading elements and limitations elements and limitations of claims 7-12.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 7-12 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Wynblatt (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 5-10; col. 1, ll. 60-67; col. 2, ll. 1-10; col. 2, ll. 22-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-

Art Unit: 3622

67; col. 6, ll. 1-55) implicitly shows the elements and limitations of claims 7-12; and it would have been obvious to modify and interpret the disclosure of Wynblatt cited above as showing each and every element in dependent claims 7-12, because modification and interpretation of the cited disclosure of Wynblatt would have provided means “*which allows access to Internet information customized to roadside advertisements. . . .*” (see Wynblatt col. 1, ll. 59-67), based on the motivation to modify Wynblatt so as to provide “*the simplest case . . . [where in] a local advertisement, a local agent could be included in a store front, and the mobile agents could be in automobiles. . . . As a driver passes by the store. . . .*” (see Wynblatt (col. 5, ll. 48-60)).

As per claim 13, Wynblatt (col. 1, ll. 40-57) implicitly shows “accessing a user profile associated with a user of a device. . . .”

Wynblatt (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 5-10; col. 1, ll. 60-67; col. 2, ll. 1-10; col. 2, ll. 22-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-55) shows a “method for providing content specific advertisements to mobile devices . . . identifying one or more of a location of the device and a time of day . . . selecting one or more advertisements based on one or more of the user profile, the location of the device, and the time of day; and . . . transmitting the advertisements selected . . . to the device.”

Art Unit: 3622

Wynblatt lacks explicit recitation of “accessing a user profile associated with a user of a device. . . .”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Wynblatt (col. 1, ll. 40-57) implicitly shows “accessing a user profile associated with a user of a device. . . .”; and it would have been obvious to modify and interpret the disclosure of Wynblatt cited above as implicitly showing “accessing a user profile associated with a user of a device. . . .”, because modification and interpretation of the cited disclosure of Wynblatt would have provided means “*which allows access to Internet information customized to roadside advertisements. . . .*” (see Wynblatt col. 1, ll. 59-67), based on the motivation to modify Wynblatt so as to provide “*the simplest case . . . [where in] a local advertisement, a local agent could be included in a store front, and the mobile agents could be in automobiles. . . . As a driver passes by the store. . . .*” (see Wynblatt (col. 5, ll. 48-60)).

As per claims 14-15, Wynblatt shows the method of claim 13 and subsequent base claims depending from claim 13.

Wynblatt (FIG. 1 & FIG. 2; and col. 2, ll. 47-67) shows the “transmitting” elements and limitations of claims 14-15.

Art Unit: 3622

Wynblatt lacks explicit recitation of the “real-time” and synchronization elements and limitations of claims 14-15.

Official Notice is taken that both the concepts and the advantages of the “real-time” and synchronization elements and limitations of claims 14-15 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Wynblatt (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 5-10; col. 1, ll. 60-67; col. 2, ll. 1-10; col. 2, ll. 22-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-55) implicitly shows the “real-time” and synchronization elements and limitations of claims 14-15; and it would have been obvious to modify and interpret the disclosure of Wynblatt cited above as showing each and every element in dependent claims 14-15, because modification and interpretation of the cited disclosure of Wynblatt would have provided means “*which allows access to Internet information customized to roadside advertisements. . . .*” (see Wynblatt col. 1, ll. 59-67), based on the motivation to modify Wynblatt so as to provide “*the simplest case . . . [where in] a local advertisement, a local agent could be included in a store front, and the mobile agents could be in automobiles. . . . As a driver passes by the store. . . .*” (see Wynblatt (col. 5, ll. 48-60)).

Art Unit: 3622

Independent claim 16 is rejected for the same reasons as independent claim 1.

Dependent claims 17-27 are rejected for the same reasons as dependent claims 2-12.

Independent claim 28 is rejected for substantially the same reasons as independent claim 13.

Dependent claims 29-30 are rejected for the same reasons as dependent claims 14-15.

As per claim 31, Wynblatt (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 5-10; col. 1, ll. 60-67; col. 2, ll. 1-10; col. 2, ll. 22-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-55) shows a “method for dynamic advertisement on a mobile device . . . identifying a plurality of advertisements; and . . . downloading the plurality of advertisements to a user’s device wherein the device displays the plurality of advertisements. . . .”

Wynblatt lacks explicit recitation of the “rotation” elements and limitations of claim 31.

Art Unit: 3622

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Wynblatt (FIG. 1) implicitly shows the “rotation” elements and limitations of claim 31; and it would have been obvious to modify and interpret the disclosure of Wynblatt cited above as implicitly showing the “rotation” elements and limitations of claim 31, because modification and interpretation of the cited disclosure of Wynblatt would have provided means *“which allows access to Internet information customized to roadside advertisements. . . .”* (see Wynblatt col. 1, ll. 59-67), based on the motivation to modify Wynblatt so as to provide *“the simplest case . . . [where in] a local advertisement, a local agent could be included in a store front, and the mobile agents could be in automobiles. . . . As a driver passes by the store. . . .”* (see Wynblatt (col. 5, ll. 48-60)).

As per claims 32-35, Wynblatt shows the method of claim 31 and subsequent base claims depending from claim 31.

Wynblatt (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 5-10; col. 1, ll. 60-67; col. 2, ll. 1-10; col. 2, ll. 22-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-55)

Wynblatt (FIG. 1 & FIG. 2; and col. 2, ll. 47-67) implicitly shows most of the elements and limitations of claims 32-35.

Art Unit: 3622

Wynblatt lacks explicit recitation of some of the elements and limitations of claims 32-35.

Official Notice is taken that both the concepts and the advantages of all the elements and limitations of claims 32-35 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Wynblatt (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 5-10; col. 1, ll. 60-67; col. 2, ll. 1-10; col. 2, ll. 22-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-55) implicitly shows the elements and limitations of claims 32-35; and it would have been obvious to modify and interpret the disclosure of Wynblatt cited above as showing each and every element in dependent claims 32-35, because modification and interpretation of the cited disclosure of Wynblatt would have provided means “*which allows access to Internet information customized to roadside advertisements. . . .*” (see Wynblatt col. 1, ll. 59-67), based on the motivation to modify Wynblatt so as to provide “*the simplest case . . . [where in] a local advertisement, a local agent could be included in a store front, and the mobile agents could be in automobiles. . . . As a driver passes by the store. . . .*” (see Wynblatt (col. 5, ll. 48-60)).

Claims 36-40 are rejected for the same reasons as claims 31-35.

Art Unit: 3622

Independent claim 41 is rejected for substantially the same reasons as independent claim 13.

As per claims 42-45, Wynblatt shows the method of claim 41.

Wynblatt (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 5-10; col. 1, ll. 60-67; col. 2, ll. 1-10; col. 2, ll. 22-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-55)

Wynblatt (FIG. 1 & FIG. 2; and col. 2, ll. 47-67) implicitly shows most of the elements and limitations of claims 42-45.

Wynblatt lacks explicit recitation of some of the elements and limitations of claims 42-45.

Official Notice is taken that both the concepts and the advantages of all the elements and limitations of claims 42-45 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Wynblatt (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 5-10; col. 1, ll. 60-67; col. 2, ll. 1-10; col. 2, ll. 22-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-55) implicitly shows the elements and limitations of claims 42-45; and it would have been obvious to modify and interpret the disclosure of Wynblatt cited above as showing each and every

Art Unit: 3622

element in dependent claims 42-45, because modification and interpretation of the cited disclosure of Wynblatt would have provided means "*which allows access to Internet information customized to roadside advertisements. . . .*" (see Wynblatt col. 1, ll. 59-67), based on the motivation to modify Wynblatt so as to provide "*the simplest case . . . [where in] a local advertisement, a local agent could be included in a store front, and the mobile agents could be in automobiles. . . . As a driver passes by the store. . . .*" (see Wynblatt (col. 5, ll. 48-60)).

CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist

Art Unit: 3622

Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


John L. Young

Primary Patent Examiner

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

August 23, 2004